

REMARKS

I. Introduction

Upon entry of the present amendment, claims 9-21 will be pending in the present application. By the present amendment, the specification and claim 9 has been amended, and new claims 11-21 have been added. No new matter has been added herein by the present amendment, as support thereof may be found in the present specification at, *inter alia*, page 5, lines 14-20; and Figures 1 and 2. The specification has also been amended herein to correct a typographical error in a previous amendment to the specification.

In view of the foregoing amendments and the following remarks, Applicant respectfully submits that the claims are now in condition for allowance. Applicant points out that the amendments made herein are made without prejudice to the future prosecution of such cancelled, amended or modified subject matter in a related divisional, continuation or continuation-in-part application.

II. Rejection of Claims Under 35 U.S.C. § 103

Claims 9-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,465,282 ("Berglund"). Applicant respectfully submits that these rejections should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, the prior art reference(s) must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). However, "a patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. ___, No. 04-1350, slip op. at 14 (April 30, 2007). Rather, "[o]ften, it will be necessary for a court to look to interrelated teachings of

multiple patents; the effects of demands known to the design community or present in the marketplace; and to the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit.” *Id.*¹ Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness in regard to the pending claims.

Berglund is allegedly directed to a fuel assembly for a nuclear reactor. According to Berglund, a “top nozzle has been provided with through-holes for connection of a top sleeve joined to the upper end of the guide thimbles. Inside the top sleeve there is arranged a first locking element intended to cooperate with a second locking element arranged at the outer surface of a guide sleeve. The guide sleeve is insertable through a hole in the top place corresponding to the top sleeve. For interlocking the guide sleeve, a locking sleeve is insertable into the guide sleeve. In this locking sleeve, according to the invention, an external, resilient third locking element is arranged for cooperation with an internal fourth locking element arranged in the guide sleeve.” Berglund, col. 2, lines 3-16.

In contrast to the teachings of Berglund, the method of the present invention as currently recited in claim 9 includes a repair sleeve having a shaft, “wherein the shaft has at least two openings, and at least two tendons extending through the openings, … each of the tendons having at least one projection configured to be inserted into a dimple of a guide thimble sleeve” (emphasis added). Dependent claims 10-21 depend from claim 9 and thus include this claim limitation as well. Berglund does not teach or suggest a method employing a repair sleeve with the presently claimed tendons.

Applicant notes that the Office Action states that “Berglund discloses applicant claim limitations except for the openings (18) and tendons (19) are located on the

¹ The USPTO has issued a memorandum explaining that, following the *KSR* decision, “it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.” Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations re: Supreme Court Decision on *KSR Int'l Co. v. Teleflex, Inc.* (May 3, 2007).

thimble insertion assembly (16 & 15) and the projections (14) are located on repair sleeve (13, 12 & 14)." (Office Action mailed 3/22/07, pages 2-3). Applicant further notes that nowhere else does the Office Action discuss the alleged "tendons" (19) of Berglund, and does not even address the present claim limitation of claim 9 reciting "at least two tendons extending through the openings." To the extent that the Office Action is equating the corbelled-out portions 19 of Berglund with the currently recited "tendons," Applicant respectfully disagrees. As can be seen in Figures 3 and 5 of Berglund, "[a] corbelled-out portion 19 is arranged *in the lower edge* of the opening 18 and extends in a direction from the centre of the locking sleeve 15." Berglund, col. 3, lines 14-16 (emphasis added). The corbelled-out portion 19 is along the edge of the opening 18, and as such in no way does it "extend through" the opening 18. In stark contrast to this arrangement of Berglund, and as can be seen in Figures 1 and 2 of the present application, the method of the present invention employs a repair sleeve having a shaft having "at least two openings, and at least two tendons extending through the openings."

Thus, for at least the preceding reasons, Berglund fails to teach or suggest each and every element of the pending claims, and thus a *prima facie* case of obviousness has not been established. In particular, Berglund does not teach or suggest a repair sleeve having a shaft, "wherein the shaft has at least two openings, and at least two tendons extending through the openings, ... each of the tendons having at least one projection configured to be inserted into a dimple of a guide thimble sleeve."

Moreover, Applicant respectfully submits that a *prima facie* case of obviousness has not been established in view of Berglund because there is no reason that one of ordinary skill in the art would modify the teachings of Berglund in order to arrive at the presently claimed invention, and the present Office Action has not identified any such reason. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). The present Office

Action merely states that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus disclosed by Berglund for universal usages as such modification is no more than the work of an expedient within the art" (Office Action mailed 3/22/07, page 4), rather than setting forth an appropriate, articulated reason for making the proposed modification. This statement, that to modify the apparatus disclosed by Berglund for universal usages is no more than the work of an *expedient* within the art, is the type of conclusory statement which fails to establish a *prima facie* case of obviousness.

That is, the present Office Action has not articulated any reason why one of ordinary skill in the art would modify the teachings of Berglund, and thereby arrive at a method including a repair sleeve having a shaft, "wherein the shaft has at least two openings, and at least two tendons extending through the openings, ... each of the tendons having at least one projection configured to be inserted into a dimple of a guide thimble sleeve."

For at least the preceding reasons, Applicant respectfully submits that the rejection of the pending claims under 35 U.S.C. § 103(a) has been overcome and should therefore be withdrawn.

III. Conclusion

It is respectfully submitted that all pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,
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